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FEE TRANSMITTAL
For FY 2006☐ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT** (\$) 500.00**Complete if Known**

Application Number	10/034,255
Filing Date	January 3, 2002
First Named Inventor	JEFFREY N. EISEN
Examiner Name	Cesar B. Paula
Art Unit	2178
Attorney Docket No.	042846-0312969

METHOD OF PAYMENT (check all that apply)☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____☒ Deposit Account Deposit Account Number: 033975 Deposit Account Name: PILLSBURY WINTHROP SHAW PITTMAN LLP

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FEE CALCULATION (All the fees below are due upon filing or may be subject to a surcharge.)**1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180
Total Claims	Extra Claims	Fee (\$)
- 20 or HP = _____ x _____ = _____		
HP = highest number of total claims paid for, if greater than 20.		
Indep. Claims	Extra Claims	Fee (\$)
- 3 or HP = _____ x _____ = _____		
HP = highest number of independent claims paid for, if greater than 3.		

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
- 100 = _____	/ 50 = _____	(round up to a whole number) x	250.00	0.00

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Brief in support of appeal

Fees Paid (\$)

500.00

SUBMITTED BY

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This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Appeal Brief Under 37 C.F.R. § 41.37
Attorney Docket No.: 042846-0312969
Application Serial No.: 10/034,255

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S) :	Jeffrey N. EISEN	CONFIRMATION NO.:	
SERIAL NUMBER :	10/034,255	EXAMINER:	Cesar B. Paula
FILING DATE :	January 3, 2002	ART UNIT:	2178
FOR :	SYSTEM AND METHOD FOR ENABLING A USER TO SELECT DOCUMENTS FROM A DISPLAY OF A SUMMARY VIEW OF DOCUMENTS AND TO CREATE A LIST OF THE SELECTED DOCUMENTS		

**Appellant's Brief on Appeal
Under 37 C.F.R. § 41.37**

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Further to the Notice of Appeal dated **August 14, 2006**, Appellant hereby submits Appellant's Brief of Appeal pursuant to 37 C.F.R. § 41.37.

The Director is authorized to charge the fee for filing an Appeal Brief pursuant to 37 C.F.R. § 41.20(b)(2), as well as any additional fees that may be due, or credit any overpayment of same, to Deposit Account No. 033975 (Ref. No. 042846-0312969).

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Appeal Brief Under 37 C.F.R. § 41.37

I. Real Party in Interest

International Business Machines Corp., the assignee of the present application, is the real party in interest.

II. Related Appeals and Interferences

There are no related appeals or interferences.

III. Status of Claims

Pending: Claims 1-25 are pending.
Cancelled: No claims are cancelled.
Rejected: Claims 1-25 stand rejected.
Allowed: No claims have been allowed.
On Appeal: Claims 1-25 are appealed.

IV. Status of Amendments

No amendments to the claims have been filed subsequent to the Final Office Action dated May 18, 2006 (hereinafter "Final Action").

V. Summary of Claimed Subject Matter

The following exemplary citations to the Specification and/or drawing figures are not exclusive, as other examples of support for claimed subject matter exist. As such, the following citations should not be viewed as limiting.

The invention is directed to a system and method for enabling a user to create a reusable list of one or more selected documents, where the list includes summary data for the documents and hyperlinks to the documents themselves. According to various aspects of the invention, the reusable list advantageously includes links to *actual* documents, rather than copies of the documents, which provides benefits in collaborative environments, as well as in many other areas. For example, multiple users may make changes to a single document, and redundancy may be avoided, and consistency achieved, because each user

makes changes to the document itself rather than individual, stand-alone copies of the document.

Independent Claim 1

Claim 1 recites a computer-implemented method, according to an aspect of the invention, which may comprise displaying a summary view of one or more entries, wherein each of the one or more entries is associated with a document and includes summary data regarding the associated document (e.g., Specification at p.5, lines 6-12).

A user may select one or more of the entries listed in the summary view (e.g., Specification at p.5, line 18 – p.6, line 3) to create a reusable list of the selected entries (e.g., Specification at p.6, lines 5-8).

The list may be created and stored in a system clipboard (e.g., Specification at p.6, lines 10-16; p.7, lines 15-16; p.7, lines 28-29).

The reusable list may include document summary data pertaining to the document associated with each of the selected entries (e.g., Specification at p.6, lines 10-16; p.7, lines 1-6), as well as a hyperlink to the document associated with the selected entry (e.g., Specification at p.6, 18-26; p.7, lines 1-6), not a copy of the document (e.g., Specification at p.7, lines 15-22). The reusable list may be able to be pasted into one or more documents or transferred to one or more programs in addition to the program displaying the summary view (e.g., Specification at p.7, line 24 – p.8, line 10).

When the user selects a hyperlink from the reusable list, a current version of a document associated with the hyperlink may be displayed (e.g., Specification at p.7, line 24 – p.8, line 10), including any changes made to the document subsequent to creating the reusable list (e.g., Specification at p.7, line 24 – p.8, line 17).

Independent Claim 8

Claim 8 recites a computer system, according to an aspect of the invention, which may comprise means for displaying a summary view of one or more entries, wherein each of the one or more entries is associated with a document and includes summary data regarding the associated document (e.g., Specification at p.5, lines 6-12).

The system may include means for enabling a user to select one or more of the entries listed in the summary view (e.g., Specification at p.5, line 18 – p.6, line 3). Non-limiting examples of the means for enabling a user to select one or more of the entries

listed in the summary view may include a computer system including a processing unit (e.g., Specification at p.8, lines 19-23; Fig. 6 element 600, 602), a computer readable medium containing software (e.g., Specification at p.8, lines 19-23; Fig. 6 element 605-06), or other means.

The system may include means for receiving a user input to create a reusable list of the selected entries, and to store the list in a system clipboard (e.g., Specification at p.6, lines 5-16; p.7, lines 15-16; p.7, lines 28-29). Non-limiting examples of the means for receiving the user input may include a computer system including a processing unit (e.g., Specification at p.8, lines 19-23; Fig. 6 element 600, 602), a computer readable medium containing software (e.g., Specification at p.8, lines 19-23; Fig. 6 element 605-06), or other means.

The system may include means for creating the reusable list of the selected entries and storing the reusable list in the system clipboard in response to the input received from the user (e.g., Specification at p.6, lines 5-16; p.7, lines 15-16; p.7, lines 28-29). Non-limiting examples of the means for creating the reusable list may include a computer system including a processing unit (e.g., Specification at p.8, lines 19-23; Fig. 6 element 600, 602), a computer readable medium containing software (e.g., Specification at p.8, lines 19-23; Fig. 6 element 605-06), or other means.

The reusable list may include document summary data pertaining to the document associated with each of the selected entries (e.g., Specification at p.6, lines 10-16; p.7, lines 1-6), as well as a hyperlink to the document associated with the selected entry e.g., Specification at p.6, 18-26; p.7, lines 1-6), not a copy of the document e.g., Specification at p.7, lines 15-22). The reusable list may be able to be pasted into one or more documents or transferred to one or more programs in addition to the program displaying the summary view (e.g., Specification at p.7, line 24 – p.8, line 10).

The system may also include means for displaying a current version of a document associated with a hyperlink, including any changes made to the document subsequent to creating the reusable list, in response to the user selecting the hyperlink from the reusable list (e.g., Specification at p.7, line 24 – p.8, line 10). Non-limiting examples of the means for displaying the current version of the document may include a computer system including a processing unit (e.g., Specification at p.8, lines 19-23; Fig. 6 element 600, 602), a computer

readable medium containing software (e.g., Specification at p.8, lines 19-23; Fig. 6 element 605-06), or other means.

Dependent Claim 14

Claim 14 recites the system according to claim 8, wherein the means for creating the reusable list further comprises means for inserting the document summary data and the hyperlinks included in the reusable list into one or more rows of a table, and wherein the table is stored in the system clipboard (e.g., Specification at p. 7 line 28 – pg. 8, line 10). Non-limiting examples of the means for inserting the document summary data and the hyperlinks into one or more rows of the table may include a computer system including a processing unit (e.g., Specification at p.8, lines 19-23; Fig. 6 element 600, 602), a computer readable medium containing software (e.g., Specification at p.8, lines 19-23; Fig. 6 element 605-06), or other means.

Independent Claim 15

Claim 15 recites a computer readable medium, according to an aspect of the invention, which may include computer readable program code embodied therein (e.g., Specification at p.8, lines 19-23; Fig. 6 elements 605-06). The computer readable program code may comprise computer readable program code for displaying a summary view of one or more entries, wherein each of the one or more entries is associated with a document and includes summary data regarding the associated document (e.g., Specification at p.5, lines 6-12).

The computer readable program code may enable the user to select one or more of the entries listed in the summary view (e.g., Specification at p.5, line 18 – p.6, line 3).

Upon receiving input from the user, computer readable code may create a reusable list of the selected entries (e.g., Specification at p.6, lines 5-8) and the list may be stored in a system clipboard (e.g., Specification at p.6, lines 10-16; p.7, lines 15-16; p.7, lines 28-29).

The reusable list may include document summary data pertaining to the document associated with each of the selected entries (e.g., Specification at p.6, lines 10-16; p.7, lines 1-6), as well as a hyperlink to the document associated with the selected entry (e.g., Specification at p.6, 18-26; p.7, lines 1-6), not a copy of the document (e.g., Specification at p.7, lines 15-22). The reusable list may be able to be pasted into one or more documents or

transferred to one or more programs in addition to the program displaying the summary view (e.g., Specification at p.7, line 24 – p.8, line 10).

When the user selects a hyperlink from the reusable list, computer readable program code may display a current version of a document associated with the hyperlink, including any changes made to the document subsequent to creating the reusable list (e.g., Specification at p.7, line 24 – p.8, line 17).

Independent Claim 23

Claim 23 recites a computer-implemented method, according to an aspect of the invention, which may comprise displaying a summary view of one or more documents, wherein each of the one or more entries is associated with a document and includes summary data regarding the associated document (e.g., Specification at p.5, lines 6-12). A user may select one or more of the entries listed in the summary view (e.g., Specification at p.5, line 18 – p.6, line 3).

A reusable list of the selected entries may be created in response to receiving a user input, (e.g., Specification at p.6, lines 5-8) and the list may be stored in a system clipboard (e.g., Specification at p.6, lines 10-16; p.7, lines 15-16; p.7, lines 28-29).

The reusable list may include document summary data pertaining to the document associated with each of the selected entries (e.g., Specification at p.6, lines 10-16; p.7, lines 1-6), as well as a hyperlink to the document associated with the selected entry (e.g., Specification at p.6, 18-26; p.7, lines 1-6), not a copy of the document (e.g., Specification at p.7, lines 15-22). The reusable list may be able to be pasted into one or more documents or transferred to one or more programs in addition to the program displaying the summary view (e.g., Specification at p.7, line 24 – p.8, line 10).

When the user selects a hyperlink from the reusable list, a current version of a document associated with the hyperlink may be displayed (e.g., Specification at p.7, line 24 – p.8, line 10), including any changes made to the document subsequent to creating the reusable list (e.g., Specification at p.7, line 24 – p.8, line 17).

Independent Claim 24

Claim 24 recites a computer-implemented method, according to an aspect of the invention, which may comprise displaying a summary view of one or more entries, wherein each of the one or more entries is associated with a document and includes summary data

regarding the associated document (e.g., Specification at p.5, lines 6-12). The summary information may include at least one of an author associated with the document, a date associated with the document, or a subject associated with the document (e.g., Specification at p.3, lines 21-29; Figs. 1, 3).

A user may select one or more of the entries listed in the summary view (e.g., Specification at p.5, line 18 – p.6, line 3).

In response to receiving an input from the user, a reusable list of the selected entries may be created (e.g., Specification at p.6, lines 5-8) and stored in a system clipboard (e.g., Specification at p.6, lines 10-16; p.7, lines 15-16; p.7, lines 28-29).

The reusable list may include document summary data pertaining to the document associated with each of the selected entries (e.g., Specification at p.6, lines 10-16; p.7, lines 1-6), as well as a hyperlink to the document associated with the selected entry (e.g., Specification at p.6, 18-26; p.7, lines 1-6), not a copy of the document (e.g., Specification at p.7, lines 15-22). The reusable list may be able to be pasted into one or more documents or transferred to one or more programs in addition to the program displaying the summary view (e.g., Specification at p.7, line 24 – p.8, line 10).

When the user selects a hyperlink from the reusable list, a current version of a document associated with the hyperlink may be displayed (e.g., Specification at p.7, line 24 – p.8, line 10), including any changes made to the document subsequent to creating the reusable list (e.g., Specification at p.7, line 24 – p.8, line 17).

VI. Grounds of Rejection to be Reviewed on Appeal

(1) Claims 1-25 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention. Final Action at 2-3.

(2) Claims 1-25 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent Application Pub. No. 2003/0097361 to Huang et al. (“Huang”) in view of “10 Minute Guide to Windows 3.1” to Barnes (“Barnes”), and further in view of Outlook 2000 & Outlook 97 screenshots (“Outlook”). Final Action at 3-8.

VII. Argument

A. The Rejection Under § 112, Second Paragraph should be Reversed Because the Claims are Clear and Definite

The Examiner has rejected claims 1-25 under § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention. In particular, the Examiner alleges that the feature of “the list is able” in claims 1, 8, 15, and 24, and “the list can be” in claim 23 is ambiguous because “it implies that the step may or may not be carried out.” Final Action at 2-3. The rejection is improper, and should be reversed, for at least the reason that the claims are clear and definite, and satisfy the statutory requirements of § 112, second paragraph.

The purpose behind the statutory requirement of § 112, second paragraph is to “reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more.” *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1378, 55 U.S.P.Q.2d 1279, 1283 (Fed. Cir. 2000). As such, Appellants are entitled to claim the invention with a *reasonable* degree of clarity and precision, and a claim is only indefinite when it is insolubly ambiguous. *See Metabolite Labs., Inc. v. Lab. Corp.*, 370 F.3d 1354, 1366, 71 U.S.P.Q.2d 1081, 1089 (Fed. Cir. 2004); *see also Xerox Corp. v. 3Com Corp.*, 458 F.3d 1310, 1323 (Fed. Cir. 2006). Moreover, describing a claim feature in functional terms is acceptable so long as it defines the bounds on the protection sought without doing so in a vague and ambiguous manner, thereby serving the notice requirement of § 112, second paragraph. *See, e.g., In re Swinehart*, 439 F.2d 210, 160 U.S.P.Q. 226 (C.C.P.A. 1971); *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 39 U.S.P.Q.2d 1783 (Fed. Cir. 1996).

As the basis of the rejection, the Examiner identifies the claim language of “the list is able” in independent claim 1, and similar language recited in independent claims 8, 15, and 23-24. In particular, the Examiner alleges that the “reusable list” being “able to be pasted into one or more documents or transferred to one or more programs” is indefinite because “it implies that the step may or may not be carried out.” Final Action at 2-3. The Examiner has failed to meet the burden of establishing indefiniteness, as the Specification provides ample description of the recited claim feature, and thus the claims are unambiguous, rather than insolubly ambiguous, as required to establish indefiniteness. For example, the

Specification discusses how the reusable list “is able to be pasted into one or more documents or transferred to one or more programs” at least at p.3, lines 1-9; p.3 lines 21-30; p.7, lines 15-22; and p.7, line 28 – p.8, line 10. Moreover, the plain language of the claim unambiguously describes what the list “is able” or “can” do. For example, claim 1 recites: “the reusable list is able to be pasted into one or more documents or transferred to one or more programs in addition to the program displaying the summary view.” A person having ordinary skill in the art would be readily able to discern the meaning of this claim feature. Claims 8, 15, and 23-24 are similarly unambiguous. Thus, the claims are clear and definite, and satisfy the requirements of § 112, second paragraph.

For at least the foregoing reasons, the Examiner’s basis for rejecting claims 1-25 is improper, and fails to meet the burden for establishing indefiniteness under § 112, second paragraph. The claim terms in question have a readily discernable plain meaning, and are described in detail in the Specification, and thus the claims serve the statutory notice requirement of § 112, second paragraph. Thus, the claims are clear and definite, and the rejection of claims 1-25 under § 112, second paragraph, should be reversed.

B. The Rejection Under § 103 should be Reversed Because the Examiner has Failed to Establish a Prima Facie Case of Obviousness.

The Examiner has rejected claims 1-25 under § 103, as allegedly being unpatentable over Huang in view of Barnes, and further in view of Outlook. Final Action at 3-8. The rejection is improper, and should be reversed, for *at least* the reason that the Examiner has failed to establish a *prima facie* case of obviousness. In particular, the Examiner has failed to establish a legally proper teaching, suggestion, or motivation to combine the references in the manner alleged. Moreover, assuming *arguendo* that there was a legally proper teaching, suggestion, or motivation to combine the references, the references relied upon, either alone or in combination, fail to disclose, teach, or suggest all the features of the claimed invention. For at least these reasons, the rejection under § 103 is improper, and should be reversed.

In order to establish a *prima facie* case of obviousness, the prior art relied upon, either individually or when combined, must disclose, teach, or suggest every feature of the claimed invention. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992). In addition, when a combination of references is relied upon, there must be a

teaching, suggestion, or motivation to combine the references in the manner claimed. *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan . . . would have selected these components for combination **in the manner claimed**”); *see also In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (“even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests **the claimed combination**”) (emphases added).

1. The Examiner has Failed to Establish a Prima Facie Case of Obviousness Because There is No Legally Proper Teaching, Suggestion, or Motivation to Combine the References in the Manner Claimed.

The rejection under § 103 is improper, and should be reversed, for at least the reason that the Examiner has failed to establish a *prima facie* case of obviousness, as there is no teaching, suggestion, or motivation to combine the references in the manner alleged.

The Examiner’s rationale for combining references is improper for at least the reason that the provided rationale contradicts the claimed invention. For example, the Examiner alleges that it would have been obvious to a person having ordinary skill in the art to combine Huang, Outlook, and Barnes “because Barnes teaches . . . copying data without disturbing the original documents. This provides the benefit of protecting, and preserving the original files attached to the email, utilizing the copy proves, so that the user is able to use those files without loss or damaging these files.” Final Action at 4, 5, 7.

However, the Examiner’s reason for combining the references is improper because it does not suggest the claimed combination. *See Rouffet*, 149 F.3d at 1359, 47 U.S.P.Q.2d at 1457-58. The Examiner’s rationale for combining the references is allegedly for providing the benefit of “protecting, and preserving the original files attaches to the email, utilizing the copy process, so that the user is able to use those files without loss or damaging these files.” Final Action at 5. In contrast, the claimed invention recites “displaying a current version of a document associated with the hyperlink, including any changes made to the document subsequent to creating the reusable list” (e.g., Independent claim 1). That is, the claimed hyperlink is “to the document associated with the selected entry, not a copy of the document.” Therefore, when a user selects the claimed hyperlink, and modifies the document associated with the selected entry, the document would reflect any changes

made by the user, and thus the original files would not be preserved. Thus, the Examiner's alleged basis for combining the references contradicts features of the claimed invention.

For at least the foregoing reasons, the Examiner has failed to provide a legally proper teaching, suggestion, or motivation to combine the references in the manner claimed. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness, and for at least this reason, the rejection should be reversed.

2. The Examiner has Failed to Establish a Prima Facie Case of Obviousness Because the References Relied Upon Fail to Disclose, Teach, or Suggest Every Feature of the Claimed Invention.

The rejection under § 103 is improper, and should be reversed, for at least the reason that the Examiner has failed to establish a *prima facie* case of obviousness, as the references relied upon, either alone or in combination, fail to disclose, teach, or suggest every feature of the claimed invention.

a. The Alleged Combination Fails to Disclose, Teach, or Suggest "creating the reusable list of the selected entries and storing the reusable list in the system clipboard."

Neither Huang, Outlook, nor Barnes, either alone or in combination, disclose, teach, or suggest "creating the reusable list of the selected entries and storing the reusable list in the system clipboard," as recited in claim 1, for example. The Examiner alleges that email messages, as disclosed by Huang, correspond to the claimed "selected entries." Final Action at 4. Furthermore, the Examiner alleges that "Outlook teaches the creation of a list by creating a copy of selected email document entries," and that "Barnes teaches the copying of information using Windows system clipboard." *Id.* Thus, the Examiner alleges that the combination of Huang and Outlook teach a creating a reusable list of selected entries, and that Barnes allegedly teaches storing such a reusable list in a system clipboard. This combination of references, even if proper, fails to disclose, teach, or suggest "creating the reusable list of the selected entries and storing the reusable list in the system clipboard," as recited in claim 1.

Assuming *arguendo* that the Examiner's characterization of Huang is correct (i.e., email messages correspond to the claimed "entries"), the combination of Outlook and Barnes nonetheless fails to disclose, teach, or suggest creating a reusable list of such entries and storing the reusable list in a system clipboard. At best, the reusable list created in

Outlook (as identified by the Examiner) is an Inbox comprising one or more email message entries. See Final Action at 4. However, the Inbox identified by the Examiner is not an Inbox that has been stored in, or pasted from, a system clipboard. See Outlook at 3.

In other words, the Examiner has failed to establish that Barnes teaches storing email messages (as disclosed by Huang) or an Inbox (as disclosed by Outlook) in a system clipboard. At best, Barnes teaches storing text, graphics, or documents in a system clipboard (Barnes at 60). In contrast, the Examiner identifies the email messages of Huang, and the Inbox of Outlook, as allegedly corresponding to the claimed “selected entries” and “reusable list.” However, Barnes does not disclose, teach, or suggest storing email messages, an Outlook Inbox, or any similar type of object in the system clipboard. For at least this reason, the combination of references fails to disclose, teach, or suggest “creating the reusable list of the selected entries and storing the reusable list in the system clipboard,” as recited in claim 1, for example.

In addition, the Examiner alleges that “Outlook teaches the creation of a list by creating a copy of selected email document entries, and pasting this copy to a word application document” using the copying mechanisms of Barnes. See Final Action at 5. However, the Examiner’s allegation is unsupported. Barnes does not teach or suggest applying the disclosed “lesson [of] how to move information between windows using Copy, Cut, and Paste in conjunction with the Clipboard” to a message, Inbox, or any other similar type of object. Rather, Barnes relates to well-known techniques of copying, cutting, and pasting text, graphics, and documents to and from the system clipboard. Moreover, the Examiner has provided several screenshots of an Outlook Inbox, but has not provided any screenshots to show “pasting [the] copy [of the Outlook Inbox] to a word application document,” as alleged. For at least this reason, the combination of references fails to disclose, teach, or suggest “creating the reusable list of the selected entries and storing the reusable list in the system clipboard,” as recited in claim 1, for example.

For at least the foregoing reasons, the Examiner has failed to establish a *prima facie* case of obviousness. In particular, the references relied upon fail to disclose, teach, or suggest all the features of the claimed invention. For at least this reason, the rejection is improper and should be reversed.

Independent claims 8, 15, and 23-24 recite similar features as those recited in independent claim 1, and are therefore allowable for at least the same reasons discussed above for independent claim 1. Dependent claims 2-7, 9-14, 16-22, and 25 depend from and add features to one of independent claims 1, 8, 15, and 23-24, and are therefore allowable for at least the reason that they depend from allowable independent claims, as well as for the further features they recite.

For example, the Examiner has failed to establish that the references relied upon, either alone or in combination, disclose, teach, or suggest that “the document summary data pertaining to the document associated with the selected entry and the hyperlink to the document associated with the selected entry are combined so that the user can click on the document summary data itself to activate the hyperlink,” as recited in dependent claims 2, 9, and 16.

The Examiner has also failed to establish that the references relied upon, either alone or in combination, disclose, teach, or suggest “creating the reusable list further comprises the step of inserting the document summary data and the hyperlink included in the reusable list into on or more rows of a table, and wherein the table is stored in the system clipboard,” as recited in dependent claims 7, 14, and 21.

b. The Alleged Combination Fails to Disclose, Teach, or Suggest “for each of the one or more selected entries, the reusable list includes . . . a hyperlink to the document associated with the selected entry, not a copy of the document.”

Neither Huang, Outlook, nor Barnes, either alone or in combination, disclose, teach, or suggest “for each of the one or more selected entries, the reusable list includes . . . a hyperlink to the document associated with the selected entry, not a copy of the document.” as recited in claim 1, for example. The Examiner alleges that “Huang discloses . . . [a] user view[ing] the email messages themselves by clicking on one of the message information.” Final Action at 4. The Examiner further alleges that this corresponds to a “hyperlink to the document associated with the selected entry.” *Id.* That is, the Examiner alleges that an Outlook Inbox is the claimed “reusable list,” and an email entry (as disclosed in Huang) is one of the claimed “selected entries.”

The Examiner has mischaracterized Huang, as Huang does not disclose, teach, or suggest “for each of the one or more selected entries, the reusable list includes . . . a hyperlink to the document associated with the selected entry, not a copy of the document,”

as recited in claim 1. Rather, Huang discusses a user viewing an email message by clicking on the message, thereby opening an email window. Such a mechanism for opening messages is not a “hyperlink,” as alleged by the Examiner. Instead, the mechanism for opening an email message in Huang is an interaction between applications (e.g., an application program interface), which is distinct from a hyperlink. *See, e.g.*, Huang at paragraphs 0041-43 (“through a set of highly integrated applications, data can be easily extracted, manipulated, and used”); 0044-0047 (“these applications can be integrated into one or more applications having modules that interface to perform the required functionality”).

Furthermore, in Huang, when the user clicks on an email message, the email message opens in a new window. *See, e.g.*, Huang at paragraph 0060 (“The user selects and views an e-mail message by clicking on the selected message, which opens an e-mail window”). Huang discloses storing e-mails in an e-mail database, and therefore opening an e-mail involves utilizing the application program interfaces described above. *See, e.g.*, Huang at paragraph 0044, 0046. In contrast, claim 1 recites “a hyperlink to the document associated with the selected entry, not a copy of the document.” At best, Huang discloses a mechanism for opening email messages, but the mechanism is not a hyperlink, as recited in claim 1, for example.

For at least the foregoing reasons, the Examiner has failed to establish a *prima facie* case of obviousness. In particular, the references relied upon fail to disclose, teach, or suggest all the features of the claimed invention. For at least this reason, the rejection is improper and should be reversed.

Independent claims 8, 15, and 23-24 recite similar features as those recited in independent claim 1, and are therefore allowable for at least the same reasons discussed above for independent claim 1. Dependent claims 2-7, 9-14, 16-22, and 25 depend from and add features to one of independent claims 1, 8, 15, and 23-24, and are therefore allowable for at least the reason that they depend from allowable independent claims, as well as for the further features they recite.

For example, the Examiner has failed to establish that the references relied upon, either alone or in combination, disclose, teach, or suggest that “the document summary data pertaining to the document associated with the selected entry and the hyperlink to

the document associated with the selected entry are combined so that the user can click on the document summary data itself to activate the hyperlink,” as recited in dependent claims 2, 9, and 16.

The Examiner has also failed to establish that the references relied upon, either alone or in combination, disclose, teach, or suggest “creating the reusable list further comprises the step of inserting the document summary data and the hyperlink included in the reusable list into on or more rows of a table, and wherein the table is stored in the system clipboard,” as recited in dependent claims 7, 14, and 21.

VIII. Claims Appendix

The pending claims (claims 1-25) are attached in **Appendix A**.

IX. Evidence Appendix

Appendix B: None.

X. Related Proceedings Appendix

Appendix C: None.

Conclusion

For at least the foregoing reasons, Appellant respectfully submits that the claims are clear, definite, and allowable over the references relied upon by the Examiner. Therefore, reversal of the rejections is respectfully requested.

Date: **November 14, 2006**

Respectfully submitted,

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Appendix A: Claims Appendix

1. **(Previously Presented)** A computer-implemented method, comprising the steps of:
 displaying a summary view of one or more entries, wherein each of the one or more entries is associated with a document and includes summary data regarding the associated document;
 enabling a user to select one or more of the entries listed in the summary view;
 receiving input from the user to create a reusable list of the selected entries and to store the list in a system clipboard;
 creating the reusable list of the selected entries and storing the reusable list in the system clipboard in response to the input received from the user, wherein
 for each of the one or more selected entries, the reusable list includes document summary data pertaining to the document associated with the selected entry, and a hyperlink to the document associated with the selected entry, not a copy of the document, and wherein the reusable list is able to be pasted into one or more documents or transferred to one or more programs in addition to the program displaying the summary view; and
 in response to the user selecting a hyperlink from the reusable list, displaying a current version of a document associated with the hyperlink, including any changes made to the document subsequent to creating the reusable list.
2. **(Previously Presented)** The method of claim 1, wherein the document summary data pertaining to the document associated with the selected entry and the hyperlink to the document associated with the selected entry are combined so that the user can click on the document summary data itself to activate the hyperlink.
3. **(Previously Presented)** The method of claim 1, wherein the one or more entries are associated with electronic mail messages.
4. **(Previously Presented)** The method of claim 1, wherein the one or more entries are associated with documents that were found by an Internet search engine.

5. **(Previously Presented)** The method of claim 1, wherein the one or more entries are associated with messages that are included in a discussion thread.

6. **(Previously Presented)** The method of claim 1, wherein the step of enabling the user to select one or more of the entries comprises the step of displaying a check-box for each of the entries, wherein the user selects an entry by placing a mark in the check-box associated with the entry.

7. **(Previously Presented)** The method of claim 1, wherein the step of creating the reusable list further comprises the step of inserting the document summary data and the hyperlinks included in the reusable list into one or more rows of a table, and wherein the table is stored in the system clipboard.

8. **(Previously Presented)** A computer system, comprising:

means for displaying a summary view of one or more entries, wherein each of the one or more entries is associated with a document and includes summary data regarding the associated document;

means for enabling a user to select one or more of the entries listed in the summary view;

means for receiving input from the user to create a reusable list of the selected entries and to store the list in a system clipboard;

means for creating the reusable list of the selected entries and storing the reusable list in the system clipboard in response to the input received from the user, wherein

for each of the one or more selected entries, the reusable list includes document summary data pertaining to the document associated with the selected entry, and a hyperlink to the document associated with the selected entry, not a copy of the document, and wherein the reusable list is able to be pasted into one or more documents or transferred to one or more programs in addition to the program displaying the summary view; and

means for displaying a current version of a document associated with a hyperlink, including any changes made to the document subsequent to creating the reusable list, in

response to the user selecting the hyperlink from the reusable list.

9. **(Previously Presented)** The system of claim 8, wherein the document summary data pertaining to the document associated with the selected entry and the hyperlink to the document associated with the selected entry are combined so that the user can click on the document summary data itself to activate the hyperlink.

10. **(Previously Presented)** The system of claim 8, wherein the one or more entries are associated with electronic mail messages.

11. **(Previously Presented)** The system of claim 8, wherein the one or more entries are associated with documents that were found by an Internet search engine.

12. **(Previously Presented)** The system of claim 8, wherein the one or more entries are associated with messages that are included in a discussion thread.

13. **(Previously Presented)** The system of claim 8, wherein the means for enabling the user to select one or more of the entries comprises means for displaying a check-box for each of the entries, wherein the user selects an entry by placing a mark in the check-box associated with the entry.

14. **(Previously Presented)** The system of claim 8, wherein means for creating the reusable list further comprises means for inserting the document summary data and the hyperlinks included in the reusable list into one or more rows of a table, and wherein the table is stored in the system clipboard.

15. **(Previously Presented)** A computer readable medium having computer readable program code embodied therein, the computer readable program code comprising:

computer readable program code for displaying a summary view of one or more entries, wherein each of the one or more entries is associated with a document and includes summary data regarding the associated document;

computer readable program code that enables the user to select one or more of the entries listed in the summary view;

computer readable program code for receiving input from the user to create a reusable list of the selected entries and to store the list in a system clipboard;

computer readable program code for creating the reusable list of the selected entries and storing the reusable list in the system clipboard in response to the input received from the user, wherein

for each of the one or more selected entries, the reusable list includes document summary data pertaining to the document associated with the selected entry, and a hyperlink to the document associated with the selected entry, not a copy of the document, and wherein the reusable list is able to be pasted into one or more documents or transferred to one or more programs in addition to the program displaying the summary view; and

computer readable program code for displaying a current version of a document associated with a hyperlink, including any changes made to the document subsequent to creating the reusable list, in response to the user selecting the hyperlink from the reusable list.

16. **(Previously Presented)** The computer readable medium of claim 15, wherein the document summary data pertaining to the document associated with the selected entry and the hyperlink to the document associated with the selected entry are combined so that the user can click on the document summary data itself to activate the hyperlink.

17. **(Previously Presented)** The computer readable medium of claim 15, wherein the one or more entries are associated with electronic mail messages.

18. **(Previously Presented)** The computer readable medium of claim 15, wherein the one or more entries are associated with documents that were found by an Internet search engine.

19. **(Previously Presented)** The computer readable medium of claim 15, wherein the

one or more entries are associated with messages that are included in a discussion thread.

20. **(Previously Presented)** The computer readable medium of claim 15, wherein the computer readable program code for enabling the user to select one or more of the entries comprises computer readable program code for displaying a check-box for each of the entries, wherein the user selects an entry by placing a mark in the check-box associated with the entry.

21. **(Previously Presented)** The computer readable medium of claim 15, wherein the computer readable program code for creating the reusable list further comprises computer readable program code for inserting the document summary data and the hyperlinks included in the reusable list into one or more rows of a table, and wherein the table is stored in the system clipboard.

22. **(Original)** A computer signal embodied in a carrier wave readable by a computing system and encoding a computer program of instructions for executing a computer process performing the method recited in claim 1.

23. **(Previously Presented)** A computer-implemented method, comprising the steps of:
displaying a summary view of one or more documents, wherein each of the one or more entries is associated with a document and includes summary data regarding the associated document;

enabling a user to select one or more of the entries listed in the summary view; and
creating a reusable list of the selected entries and storing the reusable list in a system clipboard in response to receiving input from the user, wherein

for each of the one or more selected entries, the reusable list includes document summary data pertaining to the document associated with the selected entry and a hyperlink to the document associated with the selected entry, not a copy of the document, wherein the summary data includes all summary data pertaining to the document associated with the selected entry that was included in the summary view, and wherein the list can be pasted into one or more documents or transferred to one or more programs in

addition to the program displaying the summary view; and

in response to the user selecting a hyperlink from the reusable list, displaying a current version of a document associated with the hyperlink, including any changes made to the document subsequent to creating the reusable list.

24. **(Previously Presented)** A computer-implemented method, comprising the steps of:
displaying a summary view of one or more entries, wherein each of the one or more entries is associated with a document and includes summary data regarding the associated document, the summary information including at least one of an author associated with the document or a date associated with the document or a subject associated with the document;

enabling a user to select one or more of the entries listed in the summary view;

creating a reusable list of the selected entries and storing the reusable list in a system clipboard in response to receiving input from the user, wherein

for each of the selected entries, the reusable list includes document summary data pertaining to the document associated with the selected entry and a hyperlink to the document associated with the selected entry, and wherein the reusable list is able to be pasted into one or more documents or transferred to one or more programs in addition to the program displaying the summary view; and

in response to the user selecting a hyperlink from the reusable list, displaying a current version of a document associated with the hyperlink, including any changes made to the document subsequent to creating the reusable list.

25. **(Previously Presented)** The method of claim 24, wherein the document summary data further includes a filename of the associated document.

Appendix B: Evidence Appendix

NONE

Appendix C: Related Proceedings Appendix

NONE



Addendum

Attachment 1

SYSTEM AND METHOD FOR ENABLING A USER TO SELECT DOCUMENTS
FROM A DISPLAY OF A SUMMARY VIEW OF DOCUMENTS AND TO CREATE A
LIST OF THE SELECTED DOCUMENTS